

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Grigor MARKARIAN, et al.
Application No. 10/028,718
Filed: December 28, 2001
For: METHOD AND SYSTEM FOR CONDUCTING
COMMERCE OVER A WIRELESS COMMUNICATION
NETWORK
Examiner: Igor N. BORISSOV
Group Art Unit: 3628

FILED ELECTRONICALLY**APPEAL BRIEF**

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P.O. Box 1450
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Sir:

This is an Appeal Brief under 37 C.F.R. § 41.37 in connection with the decision of the Examiner mailed on October 31, 2007, setting a three month period for response to expire on January 31, 2008, absent an extension. A Response After Final Office Action and a Notice of Appeal were filed on January 30, 2008, setting the period for filing an Appeal Brief to expire on March 30, 2008, absent an extension. A one-month extension of time is submitted herewith to extend the period for filing the Appeal Brief up to and including April 30, 2008.

This Appeal Brief fully complies with all provisions of 37 CFR 41.37(c) and each of the topics required by § 41.37 is presented herewith and is labeled appropriately. It is not believed that any additional fees are due, but if so, please charge any deficiency to Deposit Account No. 50-4402.

(1) Real Party In Interest

The real party in interest is Citicorp Development Center, Inc.

(2) Related Appeals And Interferences

Applicants previously appealed a final rejection and filed an Appeal Brief on December 20, 2005, a Supplemental Appeal Brief on April 10, 2006 responsive to the Examiner's objection, and a Reply Brief on September 5, 2006 responsive to the Examiner's Answer, whereupon the Examiner withdrew the finality of the rejection and issued a non-final office action before a decision by the Board. There are no other appeals or interferences related to this case.

(3) Status of Claims

Claims 12 and 14-18 are pending and all have been rejected.

Claims 1-11 and 13 have been canceled.

No claims have been allowed.

No claims have been withdrawn.

Claims 12 and 14-18 are hereby appealed.

(4) Status of Amendments

There are no amendments after final rejection.

(5) Summary of Claimed Subject Matter

Independent claim 12 proposes a method for conducting mobile commerce that involves transmitting in a first language a request message for merchant website information from a mobile device (Application 11:4-8 and Fig. 2), receiving the request message in the first language at a platform and identifying the first language (Application 11:8-10 and Fig. 2), translating the request message at the platform from the first language to a second language that is recognizable by a merchant website (Application 11:1-12:10 and Fig. 2), and communicating

the translated request message in the second language from the platform to the merchant website (Application 12:11-13 and Fig. 2). Independent claim 12 further proposes receiving at the platform the requested merchant website information from the merchant website in the second language (Application 12:13-14 and Fig. 2), recognizing the second language at the platform (Application 12:14-16 and Fig. 2), parsing the requested merchant website information in the second language into translatable pieces (Application 12:14-19 and Fig. 2), translating the translatable pieces of the requested website information into the first language so as to form a reply message containing the requested merchant website information in the first language (Application 12:17-21 and Fig. 2), and transmitting the reply message to the mobile device (Application 13:1-3 and Fig. 2).

Independent claim 12 additionally proposes transmitting a purchase request in response to the reply message in a first language to the platform (Application 11:4-8 and Figs. 10, 11, and 12), receiving the purchase request in the first language at a platform and identifying the first language (Application 11:8-10 and Figs. 10, 11, and 12), translating the purchase request at the platform from the first language to a second language that is recognizable by the merchant website (Application 11:10-12:10 and Figs. 10, 11, and 12), communicating the translated purchase request in the second language from the platform to the merchant website (Application 12:11-13 and Figs. 10, 11, and 12), and receiving at the platform a purchase request response from the merchant website in the second language, wherein the purchase request response includes a payment authorization request (Application 12:13-14; 25:1-7; and Figs. 10, 11, and 12). In addition, independent claim 12 proposes forwarding the purchase request response in the second language from the platform to a payment authorization system for a payment authorization response (Application 25:1-3 and Figs. 10, 11, and 12), receiving at the platform, the purchase request response, including the payment authorization response, in the second language from the payment authorization system (Application 25:4-7 and Figs. 10, 11, and 12), parsing the purchase request response in the second language into translatable pieces (Application 12:14-19 and Figs. 10, 11, and 12), translating the translatable pieces of the purchase request response into the first language so as to form a purchase request response in the first language (Application 12:17-21 and Figs. 10, 11, and 12), and transmitting the purchase

request response in the first language to the mobile device (Application 13:1-3 and Figs. 10, 11, and 12).

Independent claim 18 proposes a system for conducting mobile commerce that includes, for example, means for transmitting in a first language a request message for merchant website information from a mobile device (Application 11:4-8 and Fig. 2), means for receiving the request message in the first language at a platform and identifying the first language (Application 11:8-10 and Fig. 2), means for translating the request message at the platform from the first language to a second language that is recognizable by a merchant website (Application 11:1-12:10 and Fig. 2), and means for communicating the translated request message in the second language from the platform to the merchant website (Application 12:11-13 and Fig. 2). Independent claim 18 further proposes means for receiving at the platform the requested merchant website information from the merchant website in the second language (Application 12:13-14 and Fig. 2), means for recognizing the second language at the platform (Application 12:14-16 and Fig. 2), parsing the requested merchant website information in the second language into translatable pieces (Application 12:14-19 and Fig. 2), means for translating the translatable pieces of the requested website information into the first language so as to form a reply message containing the requested merchant website information in the first language (Application 12:17-21 and Fig. 2), and means for transmitting the reply message to the mobile device (Application 13:1-3 and Fig. 2).

Independent claim 18 additionally proposes means for transmitting a purchase request in response to the reply message in a first language to the platform (Application 11:4-8 and Figs. 10, 11, and 12), means for receiving the purchase request in the first language at a platform and identifying the first language (Application 11:8-10 and Figs. 10, 11, and 12), means for translating the purchase request at the platform from the first language to a second language that is recognizable by the merchant website (Application 11:10-12:10 and Figs. 10, 11, and 12), means for communicating the translated purchase request in the second language from the platform to the merchant website (Application 12:11-13 and Figs. 10, 11, and 12), and means for receiving at the platform a purchase request response from the merchant website in the second language, wherein the purchase request response includes a payment authorization request (Application 12:13-14; 25:1-7; and Figs. 10, 11, and 12). In addition, independent claim 18

proposes means for forwarding the purchase request response in the second language from the platform to a payment authorization system for a payment authorization response (Application 25:1-3 and Figs. 10, 11, and 12), means for receiving at the platform, the purchase request response, including the payment authorization response, in the second language from the payment authorization system (Application 25:4-7 and Figs. 10, 11, and 12), means for parsing the purchase request response in the second language into translatable pieces (Application 12:14-19 and Figs. 10, 11, and 12), means for translating the translatable pieces of the purchase request response into the first language so as to form a purchase request response in the first language (Application 12:17-21 and Figs. 10, 11, and 12), and means for transmitting the purchase request response in the first language to the mobile device (Application 13:1-3 and Figs. 10, 11, and 12).

(6) Grounds of Rejection to be Reviewed on Appeal

Claims 12 and 14-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton (U.S. Pub. No. 2005/0027610) and Bednarek (U.S. Pat. No. 6,965,868).

(7) Argument

The Rejection of Claims 12 and 14-18 Under 35 U.S.C. 103(a) Over Wharton and Bednarek is Improper

Claims 12 and 14-18 stand rejected as obvious over Wharton (U.S. Pub. No. 2005/0027610) and Bednarek (U.S. Pat. No. 6,965,868) under 35 U.S.C. § 103(a).

The proposed modification of Wharton in view of Bednarek lacks one or more limitations recited in each of independent claims 12 and 18, and there is inadequate articulated reasoning with rational underpinning to support the Examiner's legal conclusion of obviousness.

The Examiner alleges that Wharton teaches each and every element of independent claims 12 and 18 except "said arrangement is implemented in a *mobile device*" which the Examiner alleges is taught by Bednarek. On the contrary, the proposed modification of Wharton in view of Bednarek lacks one or more limitations recited in each of independent claims 12 and 18 in at least the following respects:

- Instead of (a) transmitting in a first language a request message for merchant website information from a device, (b) receiving the request message at a platform, identifying the first language, translating the request message to a second language recognizable by a merchant website, and communicating the translated request message in the second language from the platform to the merchant website, and (c) receiving at the platform the requested merchant website information from the merchant website in the second language, recognizing the second language at the platform, parsing the requested merchant website information in the second language into translatable pieces, translating the translatable pieces of the requested website information into the first language to form a reply message containing the requested merchant website information in the first language, and transmitting the reply message to the mobile device, as recited in independent claim 12 and similarly in independent claim 18, Wharton is directed to a back-end transaction processing system coupled to a plurality of vendor commerce systems in which a customer at a PC with a browser connects to an electronic mall via a portal over the Internet, navigates to a vendor's system via a link, and interacts with the vendor's system by entering a user-name and password (Wharton ¶¶ [0009], [0010] and [0036]-[0038] and FIG. 2).
- Instead of transmitting a purchase request in response to the reply message in a first language to the platform, receiving the purchase request at a platform and identifying the first language, translating the purchase request at the platform from the first language to a second language that is recognizable by the merchant website, and communicating the translated purchase request in the second language from the platform to the merchant website, as recited in independent claim 12 and similarly in independent claim 18, Wharton describes the customer selecting and saving one or more purchases to the vendor's system's shopping basket (Wharton ¶¶ [0009], [0010] and [0036]-[0038] and FIG. 2), the customer finishing shopping at the vendor's system, performing a local checkout in which transaction packets are constructed at the vendor's system and transmitted over a network to a transaction processor and stored in a global shopping basket, and navigating back to the portal via a link (Wharton ¶¶ [0039] and [0040]), and the customer selecting a global checkout option at the portal which notifies the

transaction processor, which in turn prompts the portal for customer payment information, such as a credit-card number, etc. (Wharton ¶ [0041]).

- Instead of receiving at the platform a purchase request response including a payment authorization request from the merchant website in the second language, forwarding the purchase request response in the second language from the platform to a payment authorization system for a payment authorization response, as recited in independent claim 12 and similarly in independent claim 18, Wharton describes the transaction processor aggregating and communicating with back-end processing functions, such as an accounting/billing system, an order fulfillment system, and a customer service system for multiple vendors via an interface, querying one or more vendor databases for processing rules, and processing the transaction according to the vendor's rules (Wharton ¶¶ [0042]-[0047], and Fig. 3) and the transaction processor interacting with the payment system and multiple payment verification systems via a payment verification interface provided by the payment system, and sending a transaction for payment authorization using the payment verification interface to other E-Commerce systems and vendors to enable them to interface their systems to the payment system (Wharton ¶¶ [0048]-[0051], and Figs. 1 and 4).
- Instead of receiving at the platform the purchase request response including the payment authorization response in the second language from the payment authorization system, parsing the purchase request response in the second language into translatable pieces, translating the translatable pieces of the purchase request response into the first language so as to form a purchase request response in the first language, and transmitting the purchase request response in the first language to the device, as recited in independent claim 12 and similarly in independent claim 18, Wharton describes the payment system, having determined how to process the transaction authorization request, sending the transaction to a payment interface that instructs the payment system how to communicate with multiple payment verification systems, routing the transaction to the proper payment verification system, and if authorized, sending an "auth-code" back to the transaction processor (Wharton ¶ [0053] and Figs. 1 and 4).

Bednarek fails to remedy the deficiencies of Wharton.

- Instead of (a) transmitting in a first language a request message for merchant website information from a mobile device, (b) receiving the request message at a platform, identifying the first language, translating the request message to a second language recognizable by a merchant website, and communicating the translated request message in the second language from the platform to the merchant website, and (c) receiving at the platform the requested merchant website information from the merchant website in the second language, recognizing the second language at the platform, parsing the requested merchant website information in the second language into translatable pieces, translating the translatable pieces of the requested website information into the first language to form a reply message containing the requested merchant website information in the first language, and transmitting the reply message to the mobile device, as recited in independent claim 12 and similarly in independent claim 18, Bednarek describes giving access to subscribing merchants via public network, intranet, or the Internet to their entry in a merchant information databases to upload information (Bednarek 68:6-14), to cell phone systems to retrieve data, and to users from a fixed location to view the data (Bednarek 68:15-35) using standard merchant ID's (Bednarek 68:36-43) and merchants communicating with the database that is linked to a mobile exchange via a phone line, a data line or wireless connection or the Internet (Bednarek 68:44-58) to upload information about their goods/services over a WAN, intranet or direct data line, or the Internet by establishing a web site for each merchant's information page (Bednarek 68:58-67).
- Instead of receiving at the platform the purchase request response including the payment authorization response in the second language from the payment authorization system, parsing the purchase request response in the second language into translatable pieces, translating the translatable pieces of the purchase request response into the first language so as to form a purchase request response in the first language, and transmitting the purchase request response in the first language to the mobile device, as recited in independent claim 12 and similarly in independent claim 18, Bednarek describes allowing a directory service linked to or located at a mobile exchange to access and

retrieve data from the merchant's web site stored in or converted to a format by the web server that can be sent over the cell network and displayed in an abridged version on the user's personal communication device (Bednarek 68:67-69:15).

The Examiner's reasoning appears to be that, having first thought of allowing a customer at a PC with a browser to connect to an electronic mall via a portal over the Internet and navigate to a vendor's system via a link and allowing merchants to communicate with a database linked to a mobile exchange via a wireless connection to upload information about their goods/services to a web site, one of ordinary skill would have seen the advantages in developing a system that involves transmitting in a first language a request message for merchant website information from a mobile device and receiving the request message at a platform, identifying the first language, translating the request message to a second language recognizable by a merchant website, and communicating the translated request message in the second language from the platform to the merchant website, and translating translatable pieces of a purchase request response into the first language so as to form a purchase request response in the first language, and transmitting the purchase request response in the first language to the mobile device, as recited in independent claim 12 and similarly in independent claim 18, as concluded by the Examiner. But the Examiner has not even shown how this follows, and has more critically failed to show that one of ordinary skill would have considered developing such a system to begin with.

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed.2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727 at 1740-41 (2007). The Examiner's reasoning that the development of such a system "would advantageously allow to provide the customer with information correlated to the customer cellular position, such as gas stations, hotels, restaurants and grocery stores" is conclusory in that it begins with the claim limitation and from that infers a generic benefit in hindsight. This is not a rational underpinning that shows a connection by articulated reasoning of what those of ordinary skill knew, leading to the claim limitation at issue.

Consequently, Wharton and/or Bednarek fail to disclose or suggest the required combinations of limitations recited in independent claims 12 and/or 18. Because the cited references do not teach the limitations of claims 12 and/or 18, the Examiner has failed to establish the required *prima facie* case of unpatentability. See *In re Royka*, 490 F.2d 981, 985 (C.C.P.A., 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claim); See also MPEP §2143.03. The Examiner has failed to establish the required *prima facie* case of unpatentability for independent claim 12 and/or 18 and similarly has failed to establish a *prima facie* case of unpatentability for claims 14-17 that depend on claim 12, and which recite further specific elements that have no reasonable correspondence with the references.

(8) Conclusion

For at least the reasons given above, the rejection of claims 12 and 14-18 is improper. Applicants respectfully request the final rejection by the Examiner be reversed and claims 12 and 14-18 be allowed.

Respectfully submitted,

Date: April 24, 2008

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(9) Claims Appendix

12. A method for conducting mobile commerce comprising:

transmitting in a first language a request message for merchant website information from a mobile device;

receiving the request message in the first language at a platform and identifying the first language;

translating the request message at the platform from the first language to a second language that is recognizable by a merchant website;

communicating the translated request message in the second language from the platform to the merchant website;

receiving at the platform the requested merchant website information from the merchant website in the second language;

recognizing the second language at the platform;

parsing the requested merchant website information in the second language into translatable pieces;

translating the translatable pieces of the requested website information into the first language so as to form a reply message containing the requested merchant website information in the first language; and

transmitting the reply message to the mobile device;

transmitting a purchase request in response to the reply message in a first language to the platform;

receiving the purchase request in the first language at a platform and identifying the first language;

translating the purchase request at the platform from the first language to a second language that is recognizable by the merchant website;

communicating the translated purchase request in the second language from the platform to the merchant website;

receiving at the platform a purchase request response from the merchant website in the second language, wherein the purchase request response includes a payment authorization request;

forwarding the purchase request response in the second language from the platform to a payment authorization system for a payment authorization response;

receiving at the platform, the purchase request response, including the payment authorization response, in the second language from the payment authorization system;

parsing the purchase request response in the second language into translatable pieces;

translating the translatable pieces of the purchase request response into the first language so as to form a purchase request response in the first language; and

transmitting the purchase request response in the first language to the mobile device.

14. The method according to claim 12, wherein the first language is a wireless language.

15. The method according to claim 14, wherein the wireless language is selected from the group consisting of wireless markup language (WML), handheld device mark-up language (HDML), Imode, and compact hypertext markup language (CHTML).

16. The method according to claim 12, wherein the second language is a web-based language.

17. The method according to claim 16, wherein the web-based language is selected from the group consisting of extensible markup language (XML), compact hypertext markup language

(CHTML), extensible hypertext markup language (XHTML), and hypertext markup language (HTML).

18. A system for conducting mobile commerce comprising:

means for transmitting in a first language a request message for merchant website information from a mobile device;

means for receiving the request message in the first language at a platform and identifying the first language;

means for translating the request message at the platform from the first language to a second language that is recognizable by a merchant website;

means for communicating the translated request message in the second language from the platform to the merchant website;

means for receiving at the platform the requested merchant website information from the merchant website in the second language;

means for recognizing the second language at the platform;

means for parsing the requested merchant website information in the second language into translatable pieces;

means for translating the translatable pieces of the requested website information into the first language so as to form a reply message containing the requested merchant website information in the first language; and

means for transmitting the reply message to the mobile device;

means for transmitting a purchase request in response to the reply message in a first language to the platform;

means for receiving the purchase request in the first language at a platform and identifying the first language;

means for translating the purchase request at the platform from the first language to a second language that is recognizable by the merchant website;

means for communicating the translated purchase request in the second language from the platform to the merchant website;

means for receiving at the platform a purchase request response from the merchant website in the second language, wherein the purchase request response includes a payment authorization request;

means for forwarding the purchase request response in the second language from the platform to a payment authorization system for a payment authorization response;

means for receiving at the platform, the purchase request response, including the payment authorization response, in the second language from the payment authorization system;

means for parsing the purchase request response in the second language into translatable pieces;

means for translating the translatable pieces of the purchase request response into the first language so as to form a purchase request response in the first language; and

means for transmitting the purchase request response in the first language to the mobile device.

(10) Evidence Appendix

There is no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 and no other evidence entered by the examiner and relied on by appellant in the appeal.

(11) Related Proceedings Appendix

There are no other decisions rendered by a court or the Board in any other appeals or interferences related to this case.